

### **REMARKS/ARGUMENTS**

Claims 1, 2, 4, 8, and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ostrowski (U.S. Patent No. 3,965,551) in view of Maddox et al. (U.S. Patent No. U.S. 6,306,468). Specifically, the Examiner asserts that Ostrowski discloses a process for coating steel tubing comprising applying tension to a portion of the steel tubing by employing a take-off assist device, applying a thermally curable coating to the portion of steel tubing while advancing the portion through a coating system, and curing the coating. The Examiner states that the Ostrowski process further comprises washing, rinsing and drying the tubing under tension prior to coating and applying a galvanizing material such as zinc alloy (sealer) and optionally zinc chromate to provide even greater resistance to oxidation.

The Examiner concedes that Ostrowski fails to teach an electron beam curable coating but contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used electron-beam curable material as taught by Maddox et al. instead of the thermally curable coating taught by Ostrowski.

M.P.E.P. §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed.Cir. 1990). Thus, a prima facie case of obviousness under 35 U.S.C. 103(a) can not be established by combining references without some suggestion for the combination in the references themselves.

The Ostrowski '551 reference contains no teachings regarding electron-beam curable coatings or the exposure of material coatings to an electron beam, as admitted by the Examiner in the instant Office Action. Additionally, the Maddox et al. reference contains no teaching or suggestion of applying an electron beam curable material to a portion of material under tension. The Maddox et al. reference teaches use of electron beam equipment and corresponding coatings in concert with a conventional tube coating process whereby conveyor rolls support the tubing as it moves through or past the coating application area, thereby actually teaching away from the applicant's invention. (See col. 4, lines 16-19 of the '468 patent.) Additionally, each of the Examples I-IV taught in the '468 patent specifically recite coatings applied to tube metal panels, not a continuous length of material under tension.

Accordingly, Maddox et al. simply contains no teaching or suggestion of combining the

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application of tension to a length of material, with the use of electron beam curable coatings therefor. In *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987), the Federal Circuit expressly held that the USPTO had "failed to establish a prima facie case of obviousness":

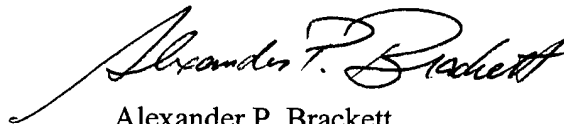
Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Accordingly, since there is no motivation, suggestion, or teaching in the prior art for combining the cited references to produce applicant's invention as claimed in claims 1, 2, 4, 8 and 9, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been supported with respect to these claims.

Claims 3 and 5-7 stand rejected under 35 U.S.C. §130(a) as being unpatentable over Ostrowski in view of Maddox et al. and further in view of Asai et al. (U.S. Patent No. 6,103,317). However, in view of the remarks contained hereinabove, and in the absence of any motivation or suggestion in the art as of the filing date of the present application that would have prompted one of ordinary skill in the art to make the claimed combination, a prima facie case of obviousness has not been established with respect to claims 3 and 5-7.

Applicant has responded to each of the Examiner's objections and rejections as set forth in the Office Action dated May 21, 2003. Based on the foregoing, applicant respectfully requests withdrawal of all claim rejections in the instant application. Allowance of all claims and prompt passage to issue are hereby courteously solicited.

Respectfully submitted,



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Attachments